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Paper No. 32  
AD

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

T.P. Saddle Blanket & Trading, Inc.  
v.  
Tasha McCarter

Cancellation No. 25,246

Thomas V. Smurzynski of Lahive & Cockfield, LLP for T.P.  
Saddle Blanket & Trading, Inc.

James F. Palecek of Palecek & Skaja for Tasha McCarter.

Before Hohein, Chapman and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 13, 1996, T.P. Saddle Blanket & Trading,  
Inc. (petitioner) filed a petition to cancel Trademark  
Registration No. 1,300,625. The underlying application  
for this registration was filed on October 27, 1982, and  
the registration issued October 16, 1984. Tasha McCarter  
(respondent) is identified as the owner. The  
registration is for the mark shown below.



The goods in the registration are identified as "men's and women's clothing, namely dresses, blouses, sweaters, shorts, shirts, and jogging suits" in International Class 25. The registration alleges a date of first use and a date of first use in commerce of April 1980. On October 11, 1990, respondent filed a combined §§ 8 and 15 affidavit, which was accepted and acknowledged respectively.

Petitioner, in its petition to cancel, claims that it has filed an application to register the mark TASHA (typed form) for goods identified as "men's and women's and children's shirts, jackets and skirts" in International Class 25. Petitioner alleges that respondent's registration is likely to bar the registration of its application and, therefore, it seeks the cancellation of the registration on the ground that "respondent is no longer using the mark it has registered. It has abandoned the mark." Petition to Cancel, p. 2.

In her answer, respondent denied the allegations of nonuse and abandonment. Both parties have filed briefs<sup>1</sup> in this case, but neither requested an oral hearing.

The record in this proceeding consists of the pleadings, the registration file, and petitioner's<sup>2</sup> two notices of reliance. With petitioner's first notice of reliance, it submitted a certified copy of the file of petitioner's trademark application, Serial No. 75/096,145; Petitioner's First Request for Admissions; and petitioner's counsel's Statement Regarding Accompanying Request for Admissions<sup>3</sup>. With its second

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<sup>1</sup> Inasmuch as the Trademark Rules do not provide for a reply brief by the party in the position of defendant, we have not considered respondent's Reply Brief.

<sup>2</sup> Respondent also filed a notice of reliance. In addition to referencing the deposition of respondent and an Office action from petitioner's application, which were included with petitioner's notices of reliance, she also submitted invoices that were not previously of record. On January 29, 2001, the Board granted petitioner's unopposed motion to strike the invoices.

<sup>3</sup> Originally, petitioner argued that respondent admitted nonuse when she failed to respond to petitioner's requests for admission that she did not use the mark TASHA and design in 1996, 1995, 1994, 1993, and 1992. During the original briefing process, respondent submitted evidence that she had timely responded to petitioner's requests for admissions. The Board in a decision dated November 24, 1997, reopened the discovery period for the limited purpose of allowing petitioner to depose respondent. The requests for admissions and the statement of petitioner's counsel accompanying the request for admissions were relevant to petitioner's original argument when it sought cancellation on the sole basis that respondent admitted abandonment when she failed to respond to petitioner's requests for admission.

notice of reliance, petitioner submitted the discovery deposition of respondent (Tasha McCarter), with exhibits.

The Trademark Act provides that:

A mark shall be deemed to be "abandoned" when either of the following occurs: (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of that made in the ordinary course of trade, and not made merely to reserve a right in a mark...

15 U.S.C. § 1127.

Petitioner has the burden to establish the case for cancellation of the registered mark on the ground of abandonment by a preponderance of the evidence.

Cerveceria Centroamericana S.A. v. Cerveceria India Inc.,  
892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

In an effort to meet its burden, petitioner primarily relies on the deposition of respondent. Petitioner acknowledges that "Ms. McCarter's answers are ambiguous, uncertain, inconsistent and sometimes incomprehensible." Petitioner's Br., p. 5. Petitioner concludes its brief with the following argument:

Ms. McCarter's deposition is a series of unstructured responses that refer to family businesses, international licensing, designing clothes, personal and family-owned corporations, and hiatuses in work and business. Petitioner believes that the explanation of Ms. McCarter's situation is that she was connected at one time with a family business that allowed her to use her name in

designing clothes, and that she has not done anything business-like with the TASHA mark for more than three years. She has no documented plan to resume use of the TASHA mark, if she ever actually used it in a true trademark sense. Her inability to get any assistance at all in preparing herself for the deposition, or in documenting use of the mark she generally claims as hers, belies a claim that a business exists that she personally controls and that uses a mark under her supervision and control.

Petitioner's Br., pp. 7-8.

Respondent argues that petitioner has failed to meet its burden of showing that respondent is no longer using her mark. Respondent points to her own deposition. In that deposition, she identifies licensees of the TASHA mark. She also identified a tag and responded "yes" when her counsel asked her: "Did you make clothes in 1991 that had this label on it." Respondent's Br., p. 6. She gave the same affirmative answer when her counsel asked her similar questions for years 1992 through 1999. Id.

Her other answers to questions during the deposition indicate that respondent is still using the mark:

"[A]ll my licensees have been there many, many years, they've been my customers today" (p. 43).

Q. To the best of your knowledge, when's the last time any women's apparel was sold in the United States under the Tasha name.

A. By me or by anyone?

Q. By anyone.

A. It's being sold anytime. It's available.

Q. When's the last time that you are aware of any sale of apparel under the Tasha name -

A. Yesterday.

Q. - in the United States? Yesterday?

A. By my licensee?

Q. By anyone.

A. Yesterday.

Q. Tell me what happened yesterday?

A. One of my licensees signed up a contract out of Chicago. (p. 47).

Q. Can you recall whether Taiwell [identified as a licensee (p. 59)] has ever sold women's apparel under the Tasha mark in the United States since 1984?

A. Yes.

Q. You can recall?

A. I know that they showed in New York last fall, in October.

Q. Did they make any sales at that time in [the] United States?

A. Yes, sir, they did.

Q. That was October 1998?

A. Yes.

Q. Do you recall whether Taiwell had any sales of women's apparel in the United States under the Tasha mark in 1991?

A. Yes. They come every year.

Q. Every year Taiwell has had sales in the United States?

A. Yes, sir. (p. 66).

Q. And the Tasha Fashion store in San Francisco is still open today?

A. They are open, but I don't operate them anymore since I close[d] retail in California. It's operated through Europe. (p. 76).

"And I have to hire people and explore more - right now I have pending inventory over \$1,000,000 of accessories on my label." (p. 115).

Q. And it's - to the best of your knowledge, Leon Stone and Associates has shown Tasha apparel every year?

A. Yes.

Q. In Los Angeles?

A. Every season, yes. (p. 142).

Q. Apart from what other people were showing at shows and offering for sale, were you personally

offering any goods bearing the Tasha mark for sale as of November 1996?

A. If I was offering to sell?

Q. (Nods head.)

A. During 1996?

Q. (Nods head.)

A. Yeah. I was selling my fashion.

Q. Where?

A. In California, in U.S.A., everywhere. But I wasn't well enough to do a lot of business. (p. 166).

While we agree with petitioner that respondent's deposition is sometimes ambiguous, uncertain, inconsistent, or incomprehensible, nonetheless petitioner, who has the burden of proof in this case, chose to rely on respondent's deposition almost exclusively. It is simply not clear what inferences we can draw from this evidence. Cerveceria, 13 USPQ2d at 1310 ("In this case an inference could properly be drawn that the trademark was not used domestically for at least two consecutive years. Based on its initial finding that no imports arrived for the eight years between 1977 and 1986, combined with its finding that the 1970's shipments were 'of very small quantities,' TTAB could properly infer that the mark was not used within the United States for at least two consecutive years between 1977 and 1986.").

Unlike in Cerveceria, we have no basis to infer that respondent has not used her mark for at least three

consecutive years based on respondent's deposition. Indeed, it would be just as reasonable to draw an inference that the mark TASHA was in use, albeit at a reduced level of activity, during the period petitioner claims there was nonuse of the mark.

Although sales by Christman and his corporation Team Concepts, Ltd. were often intermittent and the inventory of the corporation remained small, such circumstances do not necessarily imply abandonment. There is also no rule of law that the owner of a trademark must reach a particular level of success, measured either by the size of the market or by its own level of sales, to avoid abandoning a mark.

Person's Co. Ltd. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990). See also Bishop v. Equinox International Corp., 154 F.3d 1220, 47 USPQ2d 1949, 1950 (10<sup>th</sup> Cir. 1998) (District court did not clearly err when it held that the sale of 98 bottles on average per year of electrolyte solution did not result in abandonment).

Respondent does not have the positive burden to prove use of the mark; it is petitioner's burden to prove nonuse. P.A.B. Produits et Appareils de Beaute v. Santinine Societa In Nome Collecttivo di S.A. e.M. Usellini, 570 F.2d 328, 196 USPQ 801, 805 (CCPA 1978). Petitioner cannot meet this burden by relying solely on the deposition of a witness that petitioner itself describes as inconsistent, uncertain, ambiguous, and sometimes incomprehensible.



Moreover, respondent apparently experienced a series of health problems that became more intense in 1996.

McCarter dep., pp. 100-08. She reports that her illness

adversely affected her business. McCarter dep., p. 108

(Q. Do you still have a showroom at California Mart. A.

I closed that when I became very ill, because I could not attend to it."); p. 98 ("I closed my factory when I got

very ill"). Previously, we have held that a respondent

rebutted allegations of actual nonuse by demonstrating

that he had no intent to abandon a mark when he

established that he had undergone surgery and was

subsequently tried and imprisoned for a crime. Clubman's

Club Corp. v. Martin, 188 USPQ 455, 458 (TTAB 1975).

Likewise, respondent's health problems here are

consistent with her statements that she reduced her

business activity to an unspecified level, but that she

continued to use the mark on the goods.

Finally, petitioner apparently believes that it has created an inference that respondent's registration

should be cancelled because respondent has produced "no

documentary evidence of any use of TASHA by her that has

a date later than 1990." Petitioner's Br., p. 7.

However, the burden was not on respondent to prove that

it was using the mark during the period that petitioner

has alleged it was abandoned. Nonetheless, petitioner has introduced no other evidence that supports its allegation that respondent has discontinued use of the registered mark with an intent not to resume such use. While the lack of documentary evidence from respondent is unusual, it does not, based on the limited evidence in this record, provide a basis for us to infer that respondent is not using her mark on the identified goods.<sup>4</sup> Because petitioner has not established a prima facie case that respondent has abandoned her mark, petitioner's claim of abandonment must fail.

Decision: The petition to cancel is dismissed.

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<sup>4</sup> Furthermore, respondent's deposition contains numerous references to entities apparently located in the United States, Europe, and Asia, who may in some way be involved in producing or marketing goods sold under the registered mark. The names of some of these entities include: Heritage Corporation, Hapsburg Industrial Estate Property, Tess Elliott Incorporated, Tasha von Hauteinberg Company, Tasha Company, Tasha Fashions Company, Antrans, Taiwell, Marcus MacNamara, Pat MacDonald Corporation, Inter-Paul, Guisikiu, and Abdunami. To say that the relationships of many of these entities to the respondent are unclear would be an understatement. This factor, and the fact that the deposition took place at the end of the extended period for discovery, may have resulted in this issue not being developed more fully.